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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,494	01/16/2004	Michael J. Sullivan	B03-84	7679

7590

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EXAMINER

HUNTER, ALVIN A

ART UNIT PAPER NUMBER

3711

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,494

Applicant(s)

SULLIVAN, MICHAEL J.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/16/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 6-20 have been renumbered 5-19.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the composition to be anhydrous before adding water, does not reasonably provide enablement for the composition to be entirely anhydrous. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Claim 7 claims the composition as being broader than what it is disclosed to be (See Page 8, lines 18 and 19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 8, 9, 11, 12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney et al. (USPN 6232389) in view of Sullivan et al. (USPN 5984806).

Regarding claims 1, 15, and 16, Feeney et al. discloses a barrier coating for moisture resistance wherein the barrier coating may be used for golf balls (See Column 3, lines 5 through 12). The coating comprises an elastomer polymer and may be applied at the interface of two surfaces, which would inherently make it an intermediate layer (See Paragraph bridging Column 5 and 6). Feeney et al. notes that polysulfide may be used to form the coating in addition to fillers and that the coating may be applied by commonly known techniques such as dipping, spraying, brushing, etc. (See paragraph bridging Columns 8 and 9, and Column 14, lines 49 through 56). Feeney et al. also notes that the elastomer may be uncured, partially cured, or fully curable (See Column 8, lines 26 through 42). From the above, one having ordinary skill in the art would conclude that the curing temperature is not critical to attain the invention. It is evident that the coating has a moisture vapor transmission rate lower than that of the cover being that Feeney et al. notes that the coating provides moisture resistance to internal components. Applicant does not disclose why the thickness of the transmission layer is critical to attain the invention; therefore, one having ordinary skill in the art would have sought the thickness to be an obvious matter of design choice. Feeney et al. would perform equally the same at any thickness because it provides moisture

resistance to the internal components. Fenney et al. does not disclose having flakes within the composition or the vapor transmission rate. Sullivan et al. discloses a golf ball having aluminum flakes, or fillers (See Paragraph bridging columns 24 and 25). One having ordinary skill in the art would have found it obvious to incorporate flakes, as taught by Sullivan et al., in order to increase the moment of inertia of the ball. Applicant admits that the water vapor transmission rate claimed is typical for polysulfide.

Regarding claim 2, Feeney et al. inherently discloses the composition forming a tortuous path against water vapor encroachment.

Regarding claims 8 and 18, claim is directed to a product by process, therefore, it is submitted that so long as the final product is achieved the method on producing is not critical.

Regarding claim 9, Feeney et al. discloses the composition effecting wetting during formation of the barrier layer.

Regarding claim 11, Feeney et al. discloses that the two part composition may be applied using any methods known in the art (See Column 14 and 15). One having ordinary skill in the art would have come to the conclusion that the composition is miltable, extrudable, melt-flowable, castable or injection moldable.

Regarding claims 14 and 17, Applicant submits that polysulfide has a specific gravity of about 1.2 to 1.3 (See Page 6, line 15).

4. Claims 3-6, 10, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney et al. (USPN 6232389) in view of Sullivan et al. (USPN 5984806) in view of Nakanishi et al. (USPN 3714132).

Regarding claim 3, Feeney et al. in view of Sullivan et al. does not disclose the structure of the curable material. Nakanishi et al. discloses a liquid polyalkylene polysulfide in which protects from moisture and is capable of being cured in atmosphere having a recurring unit of RSS (See Columns 2, lines 1 through 22 and Abstract). One having ordinary skill in the art would have found it obvious to incorporate a liquid polysulfide into the invention of Feeney et al. in view of Sullivan et al. in order to protect against moisture.

Regarding claims 4-6, Fenney et al. in view of Sullivan et al. discloses the above but does not disclose a liquid polysulfide. Nakanishi et al. discloses a liquid polyalkylene polysulfide in which protects from moisture and is capable of being cured in atmosphere (see Abstract and Columns 1 and 2). The polysulfide is cured with agents such as peroxides of alkali metals, alkaline earth metals, as metals such as zinc peroxide, cadmium peroxide, barium peroxide, magnesium peroxide, sodium peroxide, calcium peroxide, and manganese dioxide (See Column 2, lines 31 through 44). The composition also contains sulfur (See Column 2, lines 7 through 23). One having ordinary skill in the art would have found it obvious to incorporate a liquid polysulfide into the invention of Feeney et al. in view of Sullivan et al. in order to protect against moisture.

Regarding claim 10, Nakanishi et al. discloses the polysulfide, or curable material, having a viscosity of 10 to 2000 poises, equivalent to 1000 to 200000 cP, and a molecular weight of about 1000 to 8000 (See Column 2, lines 24 through 30).

Regarding claim 19, Feeney et al. discloses a barrier coating for moisture resistance wherein the barrier coating may be used for golf balls (See Column 3, lines 5 through 12). The coating comprises an elastomer polymer and may be applied at the interface of two surfaces, which would inherently make it an intermediate layer (See Paragraph bridging Column 5 and 6). Feeney et al. notes that polysulfide may be used to form the coating in addition to fillers and that the coating may be applied by commonly known techniques such as dipping, spraying, brushing, etc. (See paragraph bridging Columns 8 and 9, and Column 14, lines 49 through 56). Feeney et al. also notes that the elastomer may be uncured, partially cured, or fully curable (See Column 8, lines 26 through 42). From the above, one having ordinary skill in the art would conclude that the curing temperature is not critical to attain the invention. It is evident that the coating has a moisture vapor transmission rate lower than that of the cover being that Feeney et al. notes that the coating provides moisture resistance to internal components. Applicant does not disclose why the thickness of the transmission layer is critical to attain the invention; therefore, one having ordinary skill in the art would have sought the thickness to be an obvious matter of design choice. Fenney would perform equally the same at any thickness because it provides moisture resistance to the internal components. Fenney et al. does not disclose having flakes within the composition or the vapor transmission rate. Sullivan et al. discloses a golf ball having aluminum flakes, or fillers (See Paragraph bridging columns 24 and 25). One having ordinary skill in the art would have found it obvious to incorporate flakes, as taught by Sullivan et al., in order to increase the moment of inertia of the ball. Applicant admits

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that the water vapor transmission rate claimed is typical for polysulfide. Feeney et al. does not disclose the structure of the curable material. Nakanishi et al. discloses a liquid polyalkylene polysulfide in which protects from moisture and is capable of being cured in atmosphere having a recurring unit of RSS (See Columns 2, lines 1 through 22 and Abstract). One having ordinary skill in the art would have found it obvious to incorporate a liquid polysulfide into the invention of Feeney et al. in order to protect against moisture.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4, 5, 7, 12, 13, 15, 16, and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-38, 40, 44-46, 48, 52-57 of copending Application No. 10/103413. Although the conflicting claims are not identical, they are not patentably distinct from each other because Discloses that same subject matter except for a water vapor transmission rate of less than about 0.6 grams*mm/m²*day. The fact that application

no. 10/103413 claims the same structure, one having ordinary skill in the art would have come to the conclusion that the application no. 10/103413 inherently teaches the same water vapor transmission rate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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